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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,862

Applicant(s)

SPETNER ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, the metes and bounds of the claim is unclear. Applicant states "the controlling step having different levels of control" in line 18, which indicates that the controlling step requires at least two or more levels of control. Since the new limitation "or" in line 11 suggests the alternative of one of the three levels of control, it makes unclear whether the method requires at least one different level of control or different levels of control.

Regarding claims 19 and 20, the claims depend from claim 18 and therefore are indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Thean et al., 6,397,036.

Regarding claim 18, Thean et al. disclose a method comprising:

provide a website of a vendor over an internet;

allow a customer to access the website by using a customer computer to view screens (web pages) relating to goods and services offered by the vendor;

display a phone number for a customer to call and obtain further information relating to the goods and services offered by the vendor;

connect a telephone call between the customer and a representative of the vendor; and,

control the screens presented to the customer computer (col. 4, lines 33-37);

control includes different levels of control; a first level of control includes sending screens to the customer computer; a second level of control comprising control the web

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enabled program of the computer, or a third level of control comprising capturing complete control of the customer. Note, since applicant's inventions requires the use of Placeware™ software and Thean et al. use the same software (col. 2, lines 8-12), it is inherent that the same software will include the different levels of control.

Regarding claim 19, the representative inputs information to be presented to the customer.

Regarding claim 20, Thean et al. teach the method further includes finalizing a purchase of goods and services. Note, since Thean et al. teach the invention for sales conferences (col. 10, line 12), it evident that some sales will occur.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7-9, 11, 12, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, 5,231,571, in view of Thean et al., 6,397,036.

Regarding claim 1, D'Agostino discloses a system comprising a computer **14**, a computer system **12**, a telephone connection **18** between the computer **14** and the computer system **12**. The computer **14** has an enabled program **64**. The computer system **12** comprises means **66** for controlling operation of the computer **14**. The controlling means **66** comprising different levels of control. The different levels of control comprise a first level, a second level, and a third level. The first level of control comprises sending screens to the computer **14** (col. 17, lines 1-5). The second level of control comprises the computer system **12** controlling operation of the enabled program (col. 10, lines 35-39). The third level comprises the computer system **12** capturing complete control of the computer (col. 16, lines 23-37 states that the representative has complete control of the computer as the representative enters the information and then later prints an application containing data of the customer; col. 17, lines 1-5).

However, the D'Agostino fails to disclose the enabled program being a web enabled program. Thean et al. teach, in Figure 1, a system comprising a computer **30** having an enabled program being a web enabled program to see visual portions of streaming video using "push" technology via the worldwide web (col. 5, lines 57-59). Therefore, as taught by Thean et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transform the enabled program into a web enabled program to see visual portions of streaming video.

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Applicant is reminded that computer system **12** is able to view different screens (Figs. 9A-9K, 9N-9U and 9Y show different screens at different times but still different screens); and, computer 14 is able to access an Internet. The computer system **12** is able of being accessed by the computer over the internet. The computer system is for providing screens to the computer once the computer accesses the computer system with such screens able to provide information and a phone number. The information relates to the products and services being offered for sale by the computer system. The phone number is for contacting a representative of the computer system.

Regarding claims 3 and 11, as modified above, the computer system further comprises a software program **70** for generating a quote based upon displayed information and for sending the quote to the web enabled program (col. 11, lines 3-11; col. 16, lines 41-47).

Regarding claims 4 and 12, D'Agostino discloses the controlling means **66** comprises another level of control comprising sending information from the computer system to the computer (data is sent to the customer computer **14**). However, the information does not include an audio file, a video clip, or a slide show presentation. Thean et al. teach information includes an audio file, a video clip, or a slide show presentation for product demonstrations or financial services (col. 4, lines 56-63). Therefore, as taught by Thean et al., it would have been obvious to one of ordinary skill

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in the art at the time the invention was made to make the information be an audio file, video clip, or a slide show presentation to present financial services, products, or both.

Regarding claim 7, a representative is capable of inputting information to be displayed on the computer capable of accessing an Internet.

Regarding claims 8 and 17, the computer system **12** further comprises a computer having a display **44** having a first window which is representative of a screen provided to the computer and a second window containing other information (col. 13, line 68 to col. 14, line 2). The first window and the second window being displayed simultaneously in the display. Column 10, in lines 35-42, states that two operations are occurring. One window allows menu control while another window displays what is shown on display **24**, thus two windows. The alternative will be the window that displays the product and the logo window that appears on every screen shot (Figs. 9B, 9C, 9D, 9F, 9N, 9O).

Regarding claim 9, D'Agostino discloses a system comprising a customer computer **14**, a customer telephone **30A**, a vendor computer system **12**, a vendor telephone **52**, and a telephone connection **18** between the customer telephone **30A** and the vendor telephone **52**. The customer computer **14** comprising a display **24**. The computer system **12** comprises a means **66** for controlling operation of the customer computer **14**. The vendor computer system **12** comprises means **66** for controlling

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operation of the customer computer **14**. The controlling means **66** comprising different levels of control. The different levels of control comprise a first level, a second level, and a third level. The first level of control comprises sending screens to the customer computer **14** (col. 17, lines 1-5). The second level of control comprises the vendor computer system **12** controlling operation of the enabled program (col. 10, lines 35-39). The third level comprises the vendor computer system **12** capturing complete control of the customer computer (col. 16, lines 23-37 states that the representative has complete control of the customer computer as the representative enters the information and then later prints an application containing data of the customer; col. 17, lines 1-5).

However, the D'Agostino fails to disclose the enabled program being a web enabled program. Thean et al. teach, in Figure 1, a system comprising a computer **30** having an enabled program being a web enabled program to see visual portions of streaming video using "push" technology via the worldwide web (col. 5, lines 57-59). Therefore, as taught by Thean et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transform the enabled program into a web enabled program to see visual portions of streaming video.

Applicant is reminded that computer system **12** is able to view different screens (Figs. 9A-9K, 9N-9U and 9Y show different screens at different times but still different screens); and, computer **14** is able to access an Internet. The vendor computer is able to being accessed by the customer computer over the internet. The vendor computer

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system is for providing a series of screens to the customer computer once the customer computer accesses the vendor computer system with such screens able to provide information relating to products and services being offered for sale by the vendor computer system and a phone number for contacting a representative of the vendor computer system.

Regarding claim 16, as modified above, the vendor computer system 12 has another level of control is controlling ~~operation~~ of the web enabled program to navigate about a web site. However, the vendor computer system does not have the website but a screen or a display. Thean et al. teach a vendor computer system having a website (Fig. 12) to place a conference to demonstrate services for marketing (col. 10, lines 4-12). Therefore, as taught by Thean et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a web site in the vendor computer system to demonstrate services or products for sale.

Claims 5, 6 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, 5,231,571, in view of Thean et al., 6,397,036, as applied to claims 1, 3, and 4 above, and further in view of Szymansky, 6,557,029.

Regarding claims 5 and 13, D'Agostino, as discussed above, discloses the telephone connection 18 not being a wireless connection. Applicant is reminded that wireless connections have been known for years (see Szymansky). Therefore, it would

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have been obvious to one of ordinary skill in the art at the time the invention was made to convert the telephone connection **18** into a wireless connection.

Regarding claims 6 and 14, given that D'Agostino uses a computer as a terminal (col. 8, lines 13-15) and suggests that other low cost microcomputers can be used (col. 8, lines 29-36). One of ordinary skill in the art will use a PDA as a handheld computer to access the web as taught by Szymansky. Note, PDAs qualify as a low cost microcomputers. Therefore, as taught by Szymansky, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the computer to be a hand held computer.

Regarding claim 15, given that D'Agostino uses a customer computer as a terminal (col. 8, lines 13-15) and suggests that other low cost microcomputers can be used (col. 8, lines 29-36). One of ordinary skill in the art will use a PDA as a handheld computer to access the web as taught by Szymansky. Note, PDAs qualify as a low cost microcomputers. Therefore, as taught by Szymansky, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the computer to be a hand held computer.

Response to Arguments

Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has argued, in respect to claims 18-20, that Thean et al. fail to anticipate the claims as the examiner has failed to show where in the reference discloses all three levels of control as claimed by applicant. In response, it is not require that all three levels be inclusively recited or explained since each of the levels of control are now phrased in the alternative. Therefore, at least one of the three levels of control needs to be pointed out by the reference to anticipate the claims.

Applicant further argued that Placeware software is an example of a software program that may be used and that the Examiner has not shown how it is inherent that the same software will include the different levels of controls and thus the examiner has not shown a *prima facie* case of anticipation. In response, one of ordinary skill in the art knows what Placeware software does. The examiner has provided the Placeware reference of Curtis et al., 6,338,086, on PTO-892 to illustrate that the different levels of controls are in the software (see Abstract). Therefore, the Placeware software, as amended, anticipates one of the three levels of control since the language is now in the alternative.

Applicant has argued, in respect to claims 1, 3-4, 7-9, 11-12 and 16-17, that the examiner has not provided a suggested desirability for making such modification. In particular, applicant argued that the examiner has not pointed out where in the prior art there is a suggestion of the desirability of such a modification. In response, applicant is urged to review column 1, line 65 to column 2, line 7, and column 10 lines 1-12. These references suggest to use a web browser to provide sales. The mere fact that web browsers did not exist during the time D'Agostino invented his method does not exclude other references that suggest web browsers to present sales over the internet in a collaborative fashion. It is this rationale that modifies D'Agostino since a web browser is just another language of programming versus a stand alone program or an older programming language.

Applicant has argued that the examiner has not pointed out where in the reference of D'Agostino does it suggest to make the desirability of transforming the enabled program into a web enabled program to see visual portions of streaming video and that D'Agostino does not discuss or suggest any other system for using his method. Applicant is reminded that obviousness is a matter of what the combined teachings would have suggested to one of ordinary skill in the art. D'Agostino does not make such suggestion but merely teaches the concept of collaborative interaction between a customer and a representative using a telephone and a computer. Thean et al., as pointed above, teach the same collaborative interaction between the customer and the teacher and suggests that the method can be applied to sales. Since Thean et al.

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suggest applying the concept to sales, teachers would be substituted for sale representatives. Applicant further argued that the customer does not operate the customer terminal. Although this argument is out of scope in terms of obviousness, the examiner finds the statement to be an admission that the representative has full control of the customer terminal as claimed. Furthermore, applicant has argued that there is no disclosure that computer 14 is able to access the internet as suggested by the examiner. In response, applicant is reminded of what comprises an internet. According to the tenth edition of the Merriam-Webster's Collegiate Dictionary, "internet" is defined as an electronic communications network that connects computer networks and organizational computer facilities around the world. Since network is a system of computers, D'Agostino's computer is connected to an electronic communication system of computers, which use the phone line through the use of modems. Thus, computer 14 is able to access the internet.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the new limitation "with the computer system being capable of viewing different screens" in lines 14-15 in claim 1 and in lines 18-19 in claim 9, and merely rephrasing "and" to "or" in line 11 of claim 18 without considering the "different levels of control" in line 8 in conjunction with "or" necessitated the new

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grounds. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EQ.



E.G.

November 29, 2004

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